

DOCKET NO.: J&J 2084
Application No.: 10/035,098
Office Action Dated: September 06, 2006

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Geoffrey P. Symonds, et al

Confirmation No.: 1700

Application No.: 10/035,098

Group Art Unit: 1635

Filing Date: December 28, 2001

Examiner: James Schultz

For: DOUBLE-STRANDED RNA-MEDIATED GENE SUPPRESSION

DATE OF DEPOSIT:

I HEREBY CERTIFY THAT THIS PAPER IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL, POSTAGE PREPAID, ON THE DATE INDICATED ABOVE AND IS ADDRESSED TO THE COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450.

TYPED NAME: Myra H. McCormack
REGISTRATION NO.: 36,602

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY PURSUANT TO 37 CFR § 1.111

In response to the Official Action dated **September 06, 2006**, reconsideration is respectfully requested in view of the amendments and/or remarks as indicated below:

- ☐ **Amendments to the Specification** begin on page of this paper.
- ☐ **Amendments to the Drawings** begin on page of this paper and include an attached replacement sheet.
- ☒ **Remarks/Arguments** begin on page 2 of this paper.

RESPONSE TO RESTRICTION REQUIREMENT

Applicants elected Group 1 (Claims 1-3, 21, 22, 24-30, 32, 33, 64-66, 69-78 and 88) with traverse in the response filed on 31 May 2006. Applicants had a telephone conversation with Examiner Schultz on Monday, February 26, 2006. In that conversation Applicant's representative wished to confirm the claim set that both Applicant's representative and the Examiner were using for the restriction requirement. Examiner Schultz indicated that the claim set to be examined were those claims in the Office Action mailed 06 September 2006. Accordingly, Applicant's representative will use this claim set in replying to the 06 September 2006 Action. Applicant's representative further understands that a new Examiner will be assigned to this case going forward. If there are any questions regarding which claim set is under Examination, Applicant's representative invites the Examiner to contact the undersigned as early as possible in an effort to minimize any confusion on either side that may occur.

The Examiner has required Applicants to elect an RNA encoding an RNA or protein that enhances the ability of dsRNA to alter expression of the gene encoding the mRNA molecule, pursuant to the language of Claim 70 or Claim 73. Accordingly, Applicants elect the protein Tat with traverse. Applicants do not believe that the searches for the pending claims would create a substantial burden for the Examiner.

The Examiner has further requested a species election with respect to cells comprising either a nucleic acid from HIV or cells that are neoplastic. Applicants elect cells that are neoplastic solely for purposes of advancing prosecution.

Finally, the Examiner has required a species election with respect to claim 32, to cells comprising a plasmid, adenoviral, an adenoassociated viral or retroviral vector. Applicants elect a retroviral vector.

Applicants reserve the right to prosecute claims directed to any non-elected inventions, deemed herein as distinct, in one or more continuing or divisional applications.

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Date: March 5, 2006

Respectfully Submitted,

/Myra H. McCormack/

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